REMARKS

Claims 1, 2 and 4 are now present in the application. Claims 1 and 4 have been amended and claims 3 and 5 have been canceled. Claims 1 and 4 are independent. Reconsideration of this application, as amended, is respectfully requested.

Examiner Interview

Interviews were conducted with the Examiner in charge of the above-identified application on December 19, 2002. In the Interview with the Examiner, the Examiner's rejections were discussed. Specifically, Applicant's representative explained to the Examiner that the new matter rejection was improper and should be withdrawn. In addition, Applicant's representative pointed out to the Examiner that the Examiner should have considered the recitations which the Examiner considered to be new matter when considering the claims with regard to the prior art.

The Examiner agreed with Applicant's representative and indicated that a supplemental Office Action would be mailed; however, the Examiner indicated that this was not possible on or about February 10, 2003. In view of this, Applicant has prepared this Amendment for the Examiner's consideration.

Status of the Drawings

In the Examiner's Office Action dated October 11, 2001, April 16, 2002 and October 1, 2002, no indication as to the status of the drawings has been provided. As the Examiner will note, the present application was filed two (2) sheets of formal drawings, as indicated on the transmittal dated July 25, 2000.

In view of the above, it is respectfully requested that the Examiner provide an indication as to the status of the drawings in the next Office Communication or forward a Notice of Draftsperson's Patent Drawing Review, PTO-948 so that Applicant can make any necessary drawing corrections in a timely manner.

In addition, a Letter to the Official Draftsperson has also been provided for the Examiner's consideration. In the Letter to the Official draftsperson, Figure 1 has been amended to include reference numerals 2a and 2b to identify the heel and forefoot portions of the outsole respectively.

Favorable consideration of the Letter to the Official Draftsperson by the Examiner is respectfully requested.

Rejection Under 35 U.S.C. § 112 and Objection to New Matter

Claims 1-5 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors,

at the time the application was filed, had possession of the claimed invention. This rejection is respectfully traversed.

At the outset, it is respectfully pointed out that claims 3 and 5 have been canceled. Accordingly, the rejection under 35 U.S.C. § 112, first paragraph, has been rendered moot with regard to these claims.

The Examiner asserts that the phrases "heel portion" and "forefoot portion" do not appear in the specification. As the Examiner will note, page 6, the paragraph beginning on 14 has been amended to describe the heel and forefoot portion of the outsole. In addition, the drawings have been amended to include reference numerals 2a and 2b to identify the heel and forefoot portions of the outsole, respectively.

On page 5, paragraph 6 of the Examiner's Office Action, the Examiner objects to the phrases "heel portion" and "forefoot portion" as being new matter, since the recitations do not appear in the specification. Applicant respectfully submits that the Examiner is incorrect in this assertion. The Examiner is directed to MPEP § 608.04, which indicates that the drawings and specification can be relied on as a disclosure of the invention. Referring to Figure 1 of the drawings as originally filed, spikes 3 are clearly illustrated as being on the heel portion and the forefoot portion of the outsole 1. Since one having ordinary skill in the art would be able to readily ascertain the heel and forefoot portion of an outsole, Applicant submits that it is not new matter to recite that the spikes are located on the heel and forefoot portions of the outsole as in amended claims 1 and 4.

Accordingly, the Examiner's objection to these recitations as being new matter is improper and should be withdrawn.

In view of the above amendments and remarks, Applicant respectfully submits that claims 1, 2 and 4 are sufficiently described in the specification. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph are respectfully requested.

Rejection Under 35 U.S.C. § 103

Claims 1-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kataoka et al., USPN 5,533,282 in view of Wideman et al., USPN 5,922,792 and Norton, USPN 4,559,724. This rejection is respectfully traversed.

At the outset, it is respectfully pointed out that claims 3 and 5 have been canceled. Accordingly, the rejection under 35 U.S.C. § 103 has been rendered moot with regard to these claims.

The Examiner asserts that Kataoka et al. discloses all of the elements of independent claims 1 and 4 except for the specific synthetic resin, which is used for the spike. Specifically, the Examiner asserts that the spike and the plate to which it is attached comprise synthetic resin.

Although Applicant believes that the independent claims of the present invention were clear with regard to which portion of the shoe should be considered the spike, in order to expedite prosecution, claims 1 and 4 have been amended to recite "an entirety of said plurality of spikes being made of a molded

rubber material" and that the plurality of spikes are removably mounted to the outsole. In view of this, to the extent the Examiner was considering the spike attaching portion 4 to be a part of the spike, since Kataoka et al. does not disclose that the spike 9 is made of a molded rubber material, this reference fails to disclose "an entirety of said plurality of spikes being made of a molded rubber material" as required by the independent claims of the present invention. In addition, the spike attaching portion 4 cannot be considered to be a part of the spike, since the spike attaching portion 4 is not removably mounted to the outsole.

In view of the above, Applicant respectfully submits that the Kataoka et al. reference fails to disclose spikes 9 being made of the same material as the hard plate 2 and therefore Kataoka et al. fails to disclose making spikes 9 of a molded rubber material as required by the independent claims of the present invention.

In view of the above, Applicant respectfully submits that the Examiner's modification of the Kataoka et al. reference is improper. The Examiner relies on Wideman et al. to teach the specific synthetic resin. The synthetic resin in Wideman et al. is not a hard material as is the hard plate 2 of Kataoka et al. Since there is no indication in Kataoka et al. that the spikes 9 are made from a synthetic resin material, and in particular a soft synthetic material, Applicant respectfully submits that one having ordinary skill in the art would not be motivated to modify the Kataoka et al. spike in view of the Wideman et al. teaching as asserted by the Examiner.

Specifically, since the shoe of Kataoka et al. is used for track and field events, Applicant respectfully submits that it is very likely that the spikes 9 are made of a very hard material such as metal, ceramic or a hard synthetic resin material. Since the synthetic resin material of Wideman et al. is a soft material, one having ordinary skill in the art would not be motivated to use the material of Wideman et al. to construct the spike 9 of Kataoka et al. Referring to column 8, lines 21-31 of Wideman et al., for example, the material of Wideman et al. is used to form tires, belts, hoses, etc. Referring to claim 9 of Wideman et al. it is also indicated that rubber shoe heels and soles can be constructed of this material. Although this is more related to the Kataoka et al. invention, it clearly indicates that the material is used only for "rubber" shoe heels and soles and therefore the material is clearly a soft material which would be much softer than the spikes 9 of Kataoka et al.

In view of the above, Applicant respectfully submits that the modification proposed by the Examiner is unreasonable. The Examiner has provided absolutely no suggestion to provide soft spikes in the Kataoka et al. shoe. Accordingly, the Examiner's rejection should be withdrawn.

It should also be noted that the Examiner relies on the Norton reference for the teaching that spikes of a shoe sole are known to be formed from a synthetic resin having a lower hardness than a remainder of the sole. Applicant respectfully submits that Norton does not teach what the Examiner indicates is being teached. The cleats of Norton are not spikes. The cleats of Norton would

be equivalent to the ground contact portions 11 of the present invention and the spike attaching portions 30 which include projecting portions 40 formed integrally therewith (See Fig. 1 of Kataoka et al.). This can be clearly understood due to the fact that Norton also discloses removable spikes, which appear to be made up of a metal material. The spikes are attached to spikes fasteners 48A-48F. In order for Norton et al. to disclose what the Examiner asserts is disclosed by Norton, it would be necessary for the spikes, which would be attachable to the spike fasteners 48A-48F, to be made of a synthetic resin material. Since the Norton reference fails to disclose spikes made of a synthetic resin material, Applicant respectfully submits that the Norton reference fails to make up for the deficiencies of Kataoka et al. and Wideman et al.

With regard to the Wideman et al. references itself, to the extent that the Examiner's modification of the Kataoka et al. reference is proper, a fact which Applicant does not agree with, Applicant respectfully submits that the material of Wideman et al. fails to teach a JIS-C hardness in the range of from 35-95 as recited by the independent claims of the present invention. The Examiner recognizes that Wideman et al. teaches a hardness of 50.5 shore hardness. Applicant respectfully submits that the shore hardness of 50.5 is outside the range of hardness recited in the independent claims of the present invention. A JIS-C hardness of from 35-95 is converted to shore hardness of from 70-100. Namely, a hardness of 50.5 (shore hardness; column 10, lines 25-48 in Wideman et al.) is not within the range of 35-90 JIS-C hardness. It would be necessary for

Wideman et al. teach a shore hardness of from 70-100 in order to be within the claimed range.

In view of the above, neither the Kataoka et al. or Wideman et al. references teach the hardness recited in the independent claims of the present invention. Accordingly, the Examiner's rejection under 35 U.S.C. § 103 is improper and should be withdrawn.

Referring to page 6, second full paragraph of the Examiner's Office Action, the Examiner states "the claimed range of hardness would be readily determined through routine optimization by one having ordinary skill in the art depending on the desire and use of the product." Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness in the present case. In order to establish a *prima facie* case of obviousness, the Examiner must set forth some rationale or suggestion of why it would be obvious to modify a reference in a particular manner. In the present case, the Examiner has provided absolutely no reason to modify the Kataoka et al. reference in the manner asserted by the Examiner. Accordingly, the Examiner's rejection is improper and should be withdrawn.

As mentioned above, Applicant respectfully submits that one having ordinary skill in the art would not be motivated to modify the Kataoka et al. reference in view of the Wideman et al. reference, since the Wideman et al. reference teaches a very soft material, while Kataoka et al. teaches very hard material. Since there is no teaching provided by the Examiner to provide

Kataoka et al. with a soft spike, one having ordinary skill in the art would not modify the Kataoka et al. shoe as proposed. The Examiner cites the *In re Boesch and Slaney* case for the proposition that it would have been obvious to vary the hardness since the hardness would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Wideman et al. The Examiner's reliance on this case is not applicable in the present situation. The Examiner still relies on the Wideman et al. reference as a teaching to construct the spikes of Kataoka et al. having a hardness within the range recited in the independent claims of the present invention. However, since Kataoka et al. does not disclose a spike made up of a synthetic resin material and the Wideman et al. reference does not disclose a hardness within the range recited in the independent claims of the present invention, the Examiner has not established a *prima facie* case of obviousness. Specifically, Wideman et al. discloses a hardness outside of the claimed range. In view of this, any modification of the combination of Kataoka et al. and Wideman et al. would be contrary to the teachings of Wideman et al. and therefore non-obvious.

In addition, independent claims 1 and 4 recite "a difference (C1-C2) between a hardness C1 of the ground contact portion of the spike and a hardness C2 of the projected portion is in the range from 5-80." Applicant respectfully submits that the references relied on by the Examiner also fail to teach or suggest this aspect of the present invention.

Referring to page 13, last paragraph through page 14, first paragraph of the present specification, setting the difference in hardness in the range from 5-80 is advantageous in order to prevent the golfer's foot from slipping on grass and hard ground and to prevent the spike from wearing and chipping. Since the references relied on by the Examiner fail to teach this aspect of the present invention, it is respectfully submitted that the Examiner's rejection is improper and should be withdrawn for this reason as well.

Referring to the Examiner's Office Action at page 4, last paragraph, the Examiner indicates that routine optimization would be used to arrive at the present invention. Applicant respectfully submits that the Examiner has also not established a *prima facie* case of obviousness with regard to this modification of the Kataoka et al. reference as well. The hardness difference disclosed by Norton is not within the range recited by the independent claims. Therefore, Norton teaches away from the claimed invention.

Finally, as the Examiner will note, independent claims 1 and 4 recite "a plurality of spikes located on the heel portion and the forefoot portion of said sole, each of said plurality of spikes including a disk shaped portion and a plurality of pins." Applicant respectfully submits that the Kataoka et al. reference fails to disclose this aspect of the present invention as well. Referring to Fig. 2 of Kataoka et al., although spikes 9 are provided on the toe portion, there are no spikes provided on the heel portion. In addition, since the shoe of a Kataoka et al. is a running shoe, it would be contrary to the teachings of Kataoka et al. to

provide spikes on the heel portion. The Norton reference is also directed to a track shoe which does not include spikes on the heel. Accordingly, the Norton reference fails to make up for the deficiencies of Kataoka et al. with regard to this aspect of the present invention as well.

With regard to dependent claim 2, Applicant respectfully submits that this claim is allowable due to its dependence upon allowable independent claim 1, as well as for the additional limitations recited by this claims.

In view of the above amendments and remarks, Applicant respectfully submits that claims 1, 2 and 4 clearly define the present invention over the references relied on by the Examiner. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103 are respectfully requested.

CONCLUSION

All the stated grounds of rejection have been properly traversed and/or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently pending rejections and that they be withdrawn.

It is believed that a full and complete response has been made to the Office Action, and that as such, the Examiner is respectfully requested to send the application to Issue.

In the event there are any matters remaining in this application, the Examiner is invited to contact Paul C. Lewis, Registration No. 43,368 at (703) 205-8000 in the Washington, D.C. area.

Attached hereto is a marked-up version of the changes made to the application by this Amendment.

Applicant respectfully petitions under the provisions of 37 C.F.R. § 1.136(a) and § 1.17 for a two-month extension of time in which to respond to the Examiner's Office Action. The Extension of Time Fee in the amount of **$410.00** is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment: Version with Markings to Show Changes Made

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION

The paragraph beginning on page 6, line 14, has been amended as follows:

Fig. 1 is a bottom view showing golf shoes according to an embodiment of the present invention. An outsole 1 of the golf shoes is shown in Fig. 1. The outsole 1 has a body 2 having a heel portion 2a and a forefoot portion 2b, a spike 3, a first projected portion 4, and a second projected portion 5. Although not shown in Figs. 1 and 2, the golf shoes have an upper part and an insole part. The construction of the upper and insole parts are similar to that of the upper and insole parts of the conventional shoes.

IN THE CLAIMS

Claims 3 and 5 have been canceled.

The claims have been amended as follows:

1. (Three Times Amended) A shoe, comprising:

an outsole including a projected portion having a ground-contact surface formed thereon, said outsole including a heel portion and a forefoot portion; and

a plurality of spikes located on the heel portion and the forefoot portion of said outsole, each of said plurality of spikes being removably mounted to said outsole and including a disk shaped portion and a plurality of pins and having a

ground-contact portion, an entirety of said plurality of spikes being made of a molded rubber material having a JIS-C hardness in the range from 35 to 95 and an elongation at break of 280% or more; said molded rubber material contains 30 wt% or more of polybutadiene as a rubber component thereof; the difference (h1-h2) between a projected height h1 of said spike and a projected height h2 of said projected portion is in the range from 0mm to 15mm; and a difference (C1-C2) between a hardness C1 of the ground contact portion of the spike and a hardness C2 of the projected portion measured by JIS-C is in the range from 5-80.

4. (Three Times Amended) A shoe, comprising:

an outsole including a projected portion having a ground-contact surface formed thereon, said outsole including a heel portion and a forefoot portion ; and

a plurality of spikes located on the heel portion and the forefoot portion of said outsole, each of said plurality of spikes being removably mounted to said outsole and including a disk shaped portion and a plurality of pins and having a ground-contact portion, an entirety of said plurality of spikes being made of a molded rubber material having a JIS-C hardness in the range from 35 to 95 and an elongation at break of 280% or more; said molded rubber material contains 30 wt% or more of acrylonitrile-butadiene copolymer as a rubber component thereof; the difference (h1-h2) between a projected height h1 of said spike and a projected height h2 of said projected portion is in the range from 0mm to 15mm;

and a difference (C1-C2) between a hardness C1 of the ground contact portion of the spike and a hardness C2 of the projected portion measured by JIS-C is in the range from 5-80.